

REMARKS

Status of the Claims

Applicant has amended claims 1 and 5. Claims 1-14 and 17-30 remain under consideration.

Claims 1-9, and 10-13 stand rejected under 35USC103(a) based on the cited reference Wong, et al, US Patent No. 5,881,103. Claims 14-28 stand rejected under 35USC103(a) based on the cited reference Wong, et al, US Patent No. 5,881,103 in view of the disclosure of the reference Yamada, US Patent No. 5,414,751. Claims 29 and 30 stand rejected under 35USC103(a) based on the cited reference Wong, et al, US Patent No. 5,881,103 in view of the disclosure of the reference Johansson, et al, US Patent No. 5,418,837. The Examiner is respectfully requested to reconsider his rejection in view of the above amendments and the following remarks.

The Invention

Applicants' invention, as set forth in Claims 1 and 5, offers an auxiliary device for a mobile communication device with information and intelligence about the audio properties of this auxiliary device to optimize the function of the audio paths of the mobile communication device. The communication between the device (a mobile phone or a mobile phone card) and the auxiliary device (a PC, a headset, etc.) takes place using two way communication, such as by the handshake method (described in the specification), which utilizes the intelligence of the auxiliary device (microcontroller unit in the auxiliary device). Thus, the quantity or quality of the audio parameters is not limited, and since both of the primary device and the auxiliary device are intelligent, it is feasible that it is variable.

Discussion of the Cited References

The Examiner continues to cite the reference Wong et al. As previously indicated Wong et al, discloses a method in which a radio telephone device has access to the audio parameters of the auxiliary device. The parameters are stored on the auxiliary device in a memory block 220 directly readable by the interface 115 of the radiotelephone 110. This is a passive participation on the part of the auxiliary device, which is in contrast to the system of this invention in which two way communication provides an interactive transaction between the electronic device and the auxiliary device. However, it is admitted that the disclosure of Wong et al fails to teach two way communication between the accessory and electronic device. This deficiency is not remedied by the Examiner's unsupported opinion.

The operation according to the invention, as described on pages 9-11 of the application, is far more robust and flexible than the method provided by Wong. For example, the number of audio parameters can be varied programmatically. Moreover, the full handshaking in the beginning ("AUDIO_PARAMETERS_SUPPORT" message) effectively prevents erroneous detection of the auxiliary device, and the two-way communication ensures reliable transfer of the parameters. These objectives are not achieved nor considered in Wong because it lacks two way communication as required in claims 1-13 as amended.

As admitted, Wong fails to teach the use of two-way communication of data, but further it fails to teach any motivation for using two-way communication of data for loading the audio parameters from the accessory device to the DSP. The

Examiner dismisses this deficiency stating as follows:

"The Examiner maintains that such a means of two way communication was well known in the art"

There is no support for this statement in any of the art cited by the Examiner. The Examiner's statement alone, does not make it so. The Examiner is reminded that obviousness arises only from clear teaching that a method step in a reference would be beneficial to solve the problem at hand, and merely arguing that since such a method step existed it would be obvious to apply it is an improper application of the doctrine of obviousness.

In fact, there existed several ways of data communication at the time of the invention: one-way data communication, two-way data communication, where only one line is active at a time, two-way data communication, where both data lines can be active simultaneously, and others. Nothing in the teaching of Wong anticipates the use of anything other than one-way data communication for solving the problem of transferring the audio parameters from the accessory device to the DSP. Contrary to what the Examiner argues, the skilled person would even have had prejudice against using two-way communication of data with a device similar to the applicant's accessory. The Examiner has failed to provide any motivation for the skilled person to try and use two-way data communication for solving the problem at hand. It would appear that the only link is provided by the teachings of the subject application.

The Examiner argues that two-way communication of data was known at the time of the invention. However, at the time of the invention, arranging a two-way digital data communication

between two relatively small devices (or between one small device and a larger one) was not an obvious solution. This is reflected in the approach of Wong, where Wong et al has resorted to one-way digital communication, when confronted with a similar type of a problem. The result being a passive accessory device.

To even more clearly point out the distinct features of the invention compared to the general knowledge at the time of the invention, the applicant has amended the claims to recite "two-way communication of digital data". This limitation has support in the description, since all the messages between the two devices, being composed of bits, are digital. The limitation most efficiently excludes the use of two-way communication of data previously cited by the Examiner, namely two-way communication of audio data. Audio data that is communicated between devices was, and to large part still is, only analog.

Communication of digital data between small devices at the time of the invention has not been common knowledge, and the skilled person would in fact have been motivated away from using two-way communication of digital data between two small devices, in order to avoid unnecessary complication of their design. However, as applied in the system of the subject invention the benefits provided by the invention outweigh this complexity, contrary to the common belief at the time of the invention. This refutes the existence of any motivation for using two-way communication of digital data.

In the rejection of claims 14-28, the Examiner combines the reference Wong et al with the teaching of the reference Yamada. In the system of Yamada, a system controller of a mobile telephone is connected to memory which consists of a series of

memory elements which are constructed to allow the system controller to overwrite program and data steps. This overwrite process is initiated by a request by the user to the network to update the services accessible by the mobile unit. The purpose of this system is to avoid the need to replace the mobile unit in order to obtain enhanced services. There is no mention of providing audio parameters according to accessories attached to the mobile unit. Wong et al teaches that audio parameters may be stored on the auxiliary device for accessing by the electronic device to which it is connected. There is no indication in either Wong or Yamada that the solutions to such diverse problems as treated by these disclosures could be in some way complementary for enhancing the solution of Wong. It is just speculation on the part of the Examiner that the systems would be compatible in any sense. The Examiner has failed to state a *prima facie* case of obviousness.

Wong solves the problem of providing audio parameters to the electronic device by storing them on the accessory device. The approach of Wong is motivated in the description of prior art by the fact that the matching of accessories and electronic devices is problematic, if the electronic device tries to anticipate the different accessories. On the other hand, Yamada merely describes a method for updating the firmware (a computer program) of the electronic device (col. 4, lines 20-32).

There are, however, certain differences between the applicant's invention and Yamada that make the teachings of Yamada reside in another field, i.e., the applicant submits that Yamada is not of analogous art. The need for changing operating programs arises far less frequently (only a new service is offered by the operator) than the need to change the audio

parameters (when the user changes the audio mode or attaches an accessory device). Therefore, Yamada is trying to solve a completely different problem than the applicant, solving it in a different way, and ending up with a different result. Namely, Yamada solves the problem of updating the devices firmware, whereas the applicant's device is not updated, but merely the running parameters are adjusted. Moreover, Yamada uploads complete programs or such, and in the applicant's invention, the operation of one program or such (audio processing) is altered by the two-way data communication. Still, Yamada ends up with a device that is different even when the device is powered off, but the applicant's device remains the same, but only the audio parameters are changed.

Therefore, it is unlikely that any skilled person would, by combining the method of Wong (loading parameters from the accessory device) and the method of Yamada (upgrading the program of an electronic device) end up with anything else but an electronic device whose programs can be changed and the audio parameters can be loaded from the accessory by one-way communication.

The above remarks relating to the reference Wong et al are equally applicable to the rejection of claims 29 and 30. The Examiner cites the reference Johansson et al as disclosing a microcontroller within an accessory. Johansson discloses a method, wherein the programs stored in the writable memory 15 of the mobile telephone can be replaced by new versions of those programs by loading them from an external data card 22 (col. 3, lines 34-46). The purpose of Johansson, therefore, is similar to Yamada as seeks to solve the same problem of updating a cellular telephone. In Johansson, the upgrade is provide in the form of

a software upgrading module card. A CPU is indicated as part of this card. The teachings of Johansson are no more compatible with the disclosure of Wong than is Yamada. There is no indication in Johansson of providing audio parameters in an auxiliary device for communication with a memory which serves a digital signal processor of an electronic device for optimizing audio settings within the electronic device. For the same reasons as stated above, the combination of Wong and Johansson fails to support the Examiner's rejection based on obviousness.

The Issue of Obviousness

It does not appear that the Examiner has considered the claims as a whole but has dismantled the claims and pursued a search for the individual features. It is well settled that "the actual determination of the issue requires an evaluation in the light of the findings in those inquiries of the obviousness of the claimed invention as whole, not merely the differences between the claimed invention and the prior art." (Graham v. John Deere Co., 383U.S.17). The court admonishes in In re Fritch, 972F.2d1260 as follow:

"It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

According to basic tenets of patent law, in order to support an obviousness rejection, there must be some suggestion of the desirability of making the modification, aside from the subject application. The claimed invention must be considered as a whole and the references must suggest the desirability and thus the obviousness of making the modification, the references must

be viewed without the benefit of hindsight. (See MPEP sections 706.02(a) and 2141. Applicant submits that the modification of the teachings of Wong et al in order to obtain the invention, as described in the amended claims submitted herein, would not have been obvious to one skilled in the art. There is no indication that such a modification would be desirable.

For all of the above reasons, the Examiner has failed therefore to present a prima facie issue of obviousness with respect to these claims.

The Court of Appeals for the Federal Circuit stated in *Ecolochem v. Southern Cal. Edison Co.* decided on September 7, 2000 as follows:

"Our case law makes clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. See *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight."

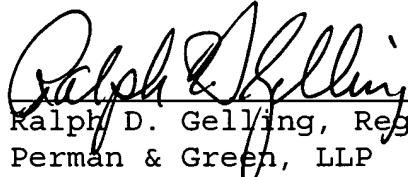
Id. "When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998) (citing *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)).

SUMMARY

In view of the amendments to this application and the arguments stated above, Applicant submits that the claims under consideration contain patentable subject matter and favorable action by the Examiner is respectfully requested.

Please charge Deposit Account No. 16-1350 for any fee deficiencies with regard to the filing of this Amendment.

Respectfully submitted,



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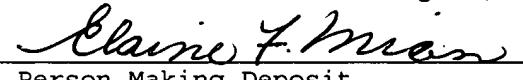


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APPENDIX A to Response to Office Action Mailed: 7/5/02

(Amendments with changes highlighted)

Application Ser. No. 09/019,614, Art Unit: 2644

1. (Amended) A method for setting audio parameters controlling processing in a digital signal processor (4) in an electronic device (1) comprising at least one auxiliary device connection (10) for connecting at least one auxiliary device (11), wherein at least some of the audio parameters are loaded into the digital signal processor (4) during operation of the electronic device (1) from the auxiliary device (11), said auxiliary device (11) conducting two way communication of digital data with said electronic device (1).

5. (Amended) An electronic device (1) comprising:

a digital signal processor (4) for processing audio signals;

means (22) for storing audio parameters controlling the processing of audio signals in the digital signal processor (4), and

an auxiliary device connection (10) for connecting an auxiliary device (11) with the electronic device (1),

wherein the electronic device (1) further comprises communication means for loading the audio parameters into the means (22) for storing the audio parameters from the auxiliary device (11), and for conducting two way

communication of digital data with the auxiliary device |
(11) .